

REMARKS

The Final Office Action mailed May 8, 2006 has been received and carefully considered. Claims 1-2, 4-11, and 13-20 are pending. Claims 1, 9, and 16 are independent. Applicants traverse the rejection.

Applicants incorporate the arguments presented in the Paper filed February 21, 2006 and present the following additional remarks here along with Applicants' reply to the Examiner's Response to Arguments.

In response to Applicants' continued objections to not being provided with a more complete copy of Towers, Applicants thank the Examiner for indicating a copy of Towers has been ordered and that it may be made available to Applicants. Applicants note that while the Examiner has only relatively recently been assigned to this case, the Patent Office has applied Towers as a reference since at least October of 2004 and presumably a copy could have been ordered and provided to Applicants at any time in the past 18 months that the Patent Office continued to apply Towers. Thus, Applicants respectfully submit that Applicants should at least have been given an opportunity to review those additional pages prior to issuance of this (second) Final Action.

With respect to the Examiner's reference to Rule 104, while the Rule may not require the entire text to be provided to Applicants, Applicants do not understand Rule 104 to condone providing Applicants with incomplete portions of pages relied upon, such as where Figures are relied upon but are not fully reproduced or where only certain steps relied upon from a multi-step process are provided while omitting others, all of which result in an incomplete teaching.

For example, the Examiner relies on page 233 of Towers in rejecting each of independent claims 1, 9 and 16. Yet, page 233 begins at step 3 of a process that is at least 7 steps. No

preceding or following pages have been provided to Applicants to aid in the context of what Towers is actually teaching. For example, of the steps numbered 3-7 that are listed on page 233, step 3 refers to a Figure that has been only partly reproduced. Steps 4, 5, and 7 each direct a reader elsewhere in the text for a definition of a term or explanation of a process, although none of these additional pages nor their contents have been provided to Applicants.

Thus, Applicants renew the argument that Towers is not an enabling reference because one of ordinary skill in the art consulting only those portions of Towers which the Examiner has cited would not be enabled to make and use anything, much less arrive at Applicants' claimed invention. Furthermore, because even the selected portions used against Applicants' claimed invention are themselves incomplete, Applicant is unable to adequately analyze the cited reference to provide a complete response, such as determining whether the pages that have not been provided to Applicants teach away from Applicants' claimed invention. Even if such pages were enabling, picking and choosing 15 pages from unrelated selections in a 355 page reference book to reconstruct Applicants' claimed invention is exactly the type of *per se* hindsight reconstruction the MPEP and case law prohibits. *See* MPEP 2143 and 2143.01. *See also*, for example, *In re Fine*, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311-313 (Fed. Cir., 1983), and *Ex parte Levengood*, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993).

In claim 16, Applicants' claimed invention requires customizing dynamic behavior of a field using at least one additional visual editor of the visual development environment. The excerpt from Towers cited by the Examiner with respect to behavior modification (page 233)

makes no reference that the behavior modification is a dynamic customization nor whether the behavior modification is taking place in the visual development environment.

In responding to Applicants' arguments regarding claim 16, the Examiner asserts that Towers teaches a dynamic customization and behavior modification at pages 142, and 145-146 but Applicants can find no teaching in Towers linking the asserted dynamic customization and behavior modification at page 233 with the teachings at pages 142 and 145-146. Thus, for at least these additional reasons, the rejection as to claim 16, and all claims depending therefrom, is improper and should be withdrawn.

Claim 1 requires that the step of customizing dynamic behavior of the inserted field comprises the steps of providing a visual editor for defining properties of the inserted field in response to the selection of at least one particular field type of the plurality of field types, providing a visual editor for defining error conditions for the inserted field in response to the selection of at least one particular field type of the plurality of field types, and providing a visual editor for defining control operations for the inserted field in response to the selection of at least one particular field type of the plurality of field types.

The limitation of "providing a visual editor for defining properties..." is stated to be found at page 145 of Towers, yet nothing at page 145 of Towers teaches or suggests dynamic customization, nor is there any teaching on page 145 that would link it to the teachings found at pages 229 and 233, the portions selected from Towers stated to teach dynamic customization. Thus, there is no teaching in Towers of customizing a visual appearance of the inserted field using a visual editor for defining properties of the inserted field in response to the selection of at least one particular field type of the plurality of field types.

In responding to Applicants arguments regarding claim 1, the Examiner asserts that Towers teaches a visual editor for defining properties through a properties inspector. However, the Examiner neither addressed the fact that claim 1 requires that the visual editor be provided “in response to the selection of at least one particular field type” nor responded to Applicants’ argument in the prior response regarding this point. See 2/21/06 Response, page 18, first full paragraph. Thus, for at least these additional reasons, the rejection as to claim 1, and all claims depending therefrom, is improper and should be withdrawn.

Boezeman overcomes none of these deficiencies and is believed to be cited only for its disclosure of error conditions as discussed below.

The Examiner admits that Towers fails to disclose providing a visual editor for defining error conditions for the inserted field in response to the selection of at least one particular field type of the plurality of field types. It is only for this proposition that Boezeman appears to be cited. Office Action at page 7. In the portion of Boezeman cited by the Examiner (col. 5:55-60), Boezeman discloses that a graphical sequence editor can be used to synchronize multimedia applications with an event, one of which might be an error condition.

The only motivation provided by the Examiner for adding Boezeman to Towers is to facilitate synchronization. Yet, Applicants can find no teaching in the selected portions of Towers provided, much less the particular page relied upon in making this rejection (page 233), that suggests synchronization is needed or desired. That it is known to use a graphical editor to synchronize a starting or stopping of a multimedia application does not mean that there is any reason to modify the teachings of Towers to include such a graphical editor as one of three visual editors for customizing the dynamic behavior of an inserted field. Thus, the only apparent

motivation provided is the Examiner's unsupported statement that it would be obvious to integrate Boezeman's graphical editor with Towers.

In responding to the Applicants' argument regarding motivation to combine, the Examiner apparently admits that neither Boezeman nor Towers provides any motivation to combine the references, but that such motivation would have been apparent to one of ordinary skill in the art based on the nature of the problem to be solved. MPEP 2143.01(I) notes that Federal Circuit case law still requires that the Examiner rely on objective evidence and make specific factual findings with respect to the motivation to combine references, but which has not been done here. See e.g., *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

With respect to claim 6, the Examiner again admits that the combination of Towers and Boezeman fail to disclose the limitation that the step of customizing dynamic behavior includes defining at least one error condition for the inserted field with the visual editor for defining error conditions. The Examiner continues to argue that a combination of the references, however, would have that "capability."

The Examiner's argument fails to show that the prior art reference teaches the claim limitation, as is required by MPEP 2143.03, which provides "[t]o establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." See also MPEP 2143.01 (III), (IV). Thus, contrary to the requirements of the MPEP, the rejection of claim 6 is a per se hindsight reconstruction based upon two references that are alleged to have a "capability." Even if the two references were properly combined, the only teaching of why that "capability" is desired and how it is actually implemented comes from Applicants' own disclosure.

The Response to Arguments section does not address the additional arguments Applicants presented regarding claim 6. Thus, for at least these additional reasons, the rejection of claim 6 is improper and should be withdrawn.

CONCLUSION

For at least the reasons above, Applicants respectfully request reconsideration of the Application and withdrawal of all outstanding rejections. As the claims are not rendered obvious in view of the applied art, Applicants request allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

This Response has been filed within two months of the mailing date of the Final Office Action and it is believed that no additional fees are due with the filing of this Response. The Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: May 23, 2006

Respectfully submitted,

MCNEES WALLACE & NURICK LLC
Attorneys for Applicants

By:

/Shawn K. Leppo/

Shawn K. Leppo, Reg. No. 50,311
P.O. Box 1166
100 Pine Street
Harrisburg, Pennsylvania 17108
Direct Dial: (717) 237-5218
Facsimile: (717) 237-5300